

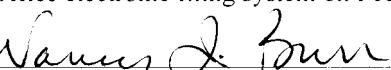
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Grantly Ross Smith	Confirmation No.	5056
Serial No.:	10/588,178	Customer No.:	28863
Filed:	March 20, 2007	Group Art Unit:	3617
Examiner:	Jason R. Bellinger	Docket No.:	1097-001US01
Title:	Wheel Rim		

---

CERTIFICATE UNDER 37 CFR 1.8 I hereby certify that this correspondence is being transmitted via the United States Patent and Trademark Office electronic filing system on February 25, 2009.

By:   
Name: Nancy J. Burr

RESPONSE TO ELECTION REQUIREMENT

Commissioner for Patents  
Alexandria, VA 22313-1450

Dear Sir:

This Response is responsive to the Election Requirement mailed February 2, 2009. Applicant acknowledges that the Examiner renumbered the claims under Rule 1.126. Claims 1-23 are pending following the renumbering.

In the Election Requirement, the Examiner identified the following species:

- a. Drawn to FIGS. 1A-B, 2A
- b. Drawn to FIGS. 2B, 3-4
- c. Drawn to FIG. 2C, 5, 6A, 7A-D, 8, 10A-B and 13A-B
- d. Drawn to FIGS. 9, 11A-B

As the basis for the Election Requirement, the Examiner indicated that the species are "not linked as to form a generic inventive concept under PCT Rule 13.1."

Applicant respectfully traverses the Election Requirement. As a matter of law, the Examiner's indication that the claims are not linked as to form a generic inventive concept under PCT Rule 13.1 is not a legitimate basis for an Election Requirement. PCT Rule 13.1 is analogous to Restriction Practice under the United States Patent law, not Elections of Species. Therefore, PCT Rule 13.1 is not a legitimate basis for imposing any Election Requirement.

Moreover, the pending claims are in full compliance with PCT Rule 13.1. Notably, the International Examination of the Application under the PCT did not identify any non-compliance with PCT Rule 13.1.

Specifically, in clear compliance with PCT Rule 13.1, all pending claims are linked as to form a generic inventive concept insofar as the claims all recite the following special technical feature "a track located on a circular band of a wheel rim."

Given that the claims satisfy Rule 13.1, the Election Requirement based on Rule 13.1 is clearly improper. Furthermore, the Examiner himself acknowledges that each of the independent claims (claims 1, 19 and 20) are generic. Therefore, the Examiner seems to acknowledge that the claims satisfy Rule 13.1 as all reciting a generic special technical feature. The Examiner's entire reliance on Rule 13.1 as a basis for an Election Requirement is improper as a matter of law, and the Examiner's comments that claims 1, 19 and 20 are generic is an acknowledgement that the claims satisfy Rule 13.1.

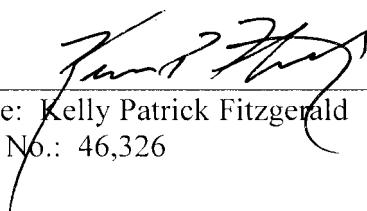
As a final point, Applicant also respectfully notes that PCT Rule 13.4 clearly indicates that subject to Rule 13.1 it shall be permitted to include in the same international application a reasonable number of dependent claims, claiming specific forms of the invention claimed in an independent claim, even where the features of any dependent claim could be considered as constituting in themselves an invention. The Examiner's reliance on PCT Rules as the rationale for an Election of Species Requirement is legally flawed.

To the extent that the Election Requirement is maintained notwithstanding the arguments above that Rule 13.1 is not a legitimate basis for imposing any Election Requirement, Applicant hereby elects Group c with traverse. Group c is drawn to FIG. 2C, 5, 6A, 7A-D, 8, 10A-B and 13A-B. Claims 1-7, 10-11 and 13-23 are readable on Group c. Each of the independent claims (claims 1, 19 and 20) are generic, as noted by the Examiner.

Date: February 25, 2009

By:

SHUMAKER & SIEFFERT, P.A.  
1625 Radio Drive, Suite 300  
Woodbury, Minnesota 55125  
Telephone: 651.286.8343  
Facsimile: 651.735.1102

  
Name: Kelly Patrick Fitzgerald  
Reg. No.: 46,326